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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,830	04/12/2001	Roberto Morlesin	Q63809	1936

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EXAMINER

LEON, EDWIN A

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 06/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/832,830

Applicant(s)

MORLESIN, ROBERTO

Examiner

Edwin A. León

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2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 7-16 is/are rejected.
- 7) ☒ Claim(s) 3-6 is/are objected to..
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2 and 9-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 recites the limitations "a receiving connector", "a first equipment station", "a second equipment station", "conductive core", "a metal conductor", "an electrical connector", "a flexible tube" and "an insulating layer". It is unclear if these receiving connectors, a first equipment station, a second equipment station, conductive core, a metal conductor, an electrical connector, a flexible tube and an insulating layer are the same as the ones recited in Claim 1 or different ones.

Claim 2 recites the limitation "the base" in Line 3. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolf (U.S. Patent No. 4,889,303). With regard to Claims 1 and 9, Wolf discloses an interconnection comprising a conductive core (formed by conductors 26) including a metal conductor (26) with, at each end thereof, an electrical connector (34,60), and a flexible tube (10) having at least an insulating layer (22) made of elastomeric material and covering the whole conductive core (formed by conductors 26). The method limitations are deemed inherent. See Figs. 1-2.

The recitation "a medium voltage" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa V. Robie*, 88 USPQ 478 (CCPA 1951).

The limitation "for realizing an electrical connection between a receiving connector of a first equipment station and a receiving connector of a second equipment station" has not been given patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex. parte Masham*, 2 USPQ2d 1647 (1987).

The limitations "adapted to electrically connect a receiving connector of a first equipment station and a receiving connector of a second equipment station", and "adapted to mate the receiving connector" have not been given patentable weight since

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it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

With regard to Claims 2 and 12, Wolf discloses the electrical connector (34,60) having a substantially conical shape of which a base (60) is connected to the metal conductor (26), the base (60) having a diameter relatively larger than the diameter of the metal conductor (26). See Figs. 1-2.

With regard to Claim 8, Wolf discloses the flexible tube (10) having the same length as the conductive core (formed by conductors 26). See Figs. 1-2.

With regard to Claims 10-11, Wolf discloses the elastomeric material being a synthetic terpolymer of ethylene, propylene and diene [EPDM] or silicone. See Lines 50-51.

### ***Allowable Subject Matter***

5. Claims 3-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 13-16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The references fail to teach, disclose, or suggest, either alone or in combination, a conical bushing means made of insulating material and provided with the receiving connector so as to bring the electrical connector of the conductive core into contact with the receiving connector and the insulating layer of the flexible tube into contact with the inner side of the bushing means, the flexible tube having coaxially starting from the center: a first semiconductive layer, an insulating layer made of elastomeric material, and a second semiconductive layer, a ring groove in the first semiconductive layer, and a ring groove partially in the insulating layer, an external locking ring on at least one electrical connector of the conductive core, and at least one internal ring groove in the flexible tube for receiving the locking ring of the electrical connector when the tube is released over the conductive core.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Noschese (U.S. Patent No. 3,034,090), Solano (U.S. Patent No. 5,271,975), Shimirak et al. (U.S. Patent No. 5,865,654), Oda et al. (U.S. Patent No. 6,315,591), Hosler, Sr. (U.S. Patent No. 5,062,808), and Wilson (U.S. Patent No. 5,037,332) an interconnection having connectors, flexible tubes and conductive cores.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin A. León whose telephone number is (703) 308-6253. The examiner can normally be reached on Monday - Friday 9:00-5:30.

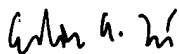
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (703) 308-2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



**THO D. TA**  
**PRIMARY EXAMINER**



**Edwin A. Leon**  
**AU 2833**

**EAL**  
**June 11, 2002**